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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/474,642	12/29/1999	THOMAS J. FOTH	E-978	2513

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EXAMINER

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/474,642

Applicant(s)

FOTH, THOMAS J.

Examiner

Richard Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 March 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1) Applicant's arguments, filed May 3, 2002, with respect to the rejection under 35 USC 101 and under 35 USC 102(e) as being anticipated by EP'956 have been fully considered and are persuasive. The rejection of corresponding claims has been withdrawn.

However, the rest of the applicant's arguments filed May 3, 2003 have been fully considered but they are not persuasive.

-- In response to applicant's argument that any person having a skill in the art could make and use the invention by setting up the refund account and it is not relevant to patentability where the refunds are coming from, the examiner respectfully disagrees with the applicant. Although the applicant seeks to clearly define who is setting up the account ("the dispute account can be set by the 'Post Office'..."), it is still deemed to be unclear who MUST set up the account because any user can abuse the system by requesting the refund without the process of authenticated by the Post Office. The applicant asserts that such loss would be limited by the threshold value and would be acceptable by the post office. However, the applicant fails to handle the potential abuses by thousands of users. It could be just \$10 for a single user, but what about for ten thousand or even more users. Further, the examiner is not informed by the post office authority whether this kind of the dispute account will be implement in the near future. Since the current claims do not point out who sets up the account, they are still deemed to be unclear whether the applicant's postage metering system actually refunds

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the spoiled postage amount from the Post Office, or diverts the fund from the additional private account (called a dispute account), which is associated with a corresponding one of the user accounts, to user.

-- In response to the applicant's argument that the dispute account is neither taught nor suggested by the references, the art rejections are nonetheless deemed to survive because of the indefiniteness of claims.

2) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action

Claim Rejections - 35 USC § 112

3) Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 1, 7, 17 and 20, respectively, the recitation of "facilitating refunds" or "refunding the postage amount to a user" renders the claim indefinite and vague because of the reasons as cited above. The claims, themselves, are silent whether the Applicant's postage metering system actually refunds the spoiled postage amount from the Post Office, or diverts the fund from the additional private account (called a dispute account), which is associated with a corresponding one of the user accounts, to user. If the dispute account were set up by the user (not by the Post Office), the reimburse process could not constitute the **refund** because the user got his/her money back from his/her other account, not from the Post Office. If the Post Office set up the dispute

account, any user could abuse the system by requesting the refund without the process of authenticated by the Post Office. Accordingly, the Applicant particularly fails to point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102

4) Claims 7-8, 16 and 20-21, as far as they are definite, are rejected under 35 U.S.C. 102(e) as being anticipated by Whitehouse (US 6,005,945).

Whitehouse discloses a postage metering system comprising:

a postage meter having a vault that accounts for postage dispensed by the postage meter (see Figs.1 and 4);

a processor that controls operation of the postage meter;

a data center (102) in communication with the postage meter, the data center having a CPU and an account database associated with the postage meter;

means (11.c) for permitting communication between the postage meter and the data center,

wherein the secure CPU determines a refund of postage (col. 24, line 53 - col. 25, line 18);

the CPU unit and the database of the data center verifying the refund and post office refunding the postage amount to a user of the postage meter; and

wherein the postage meter is remotely located from the data center.

Claim Rejections - 35 USC § 103

5) Claims 1-6, 9, 11-14 and 17-19, as far as they are definite, are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '956.

Regarding method claims, EP '956 discloses the method having the steps of:

- receiving a refund request (see Fig. 1 and abstract);
- verifying the request via a computer in the data center (5);
- sending the refund request to a postal authority by a data center;
- refunding the postage amount to a user of the postage meter;
- adjusting the user's account to reflect the refund;
- rejecting the refund by sending a disable message when the refund request has not been verified;
- wherein the postage meter is remotely located from the computer (see Fig. 1);
- maintaining a transaction record (database in the data center); and
- wherein the refund amount must correlate to a postage value previously dispensed by the postage meter.

However, EP '956 does not expressively disclose:

- the method of determining if a value in the user's account is acceptable for permitting a refund of the postage amount;
- sending enabling data from the computer to the postage meter to effectuate the refund; and
- the method of mailing funds equivalent to the postage amount to the user.

As long as the Post Office can authenticate whether the user has a compelling reason for the refund and the user has a valid account, any user's account is acceptable for permitting the refund of the postage amount. In order to effectuate the refund, the data transmission between the data center and the postage meter is clearly required. As Fig. 1 of EP '956 shows the diagram depicting that the data center is communicating with the postage meter, it is well known in the art to send data from one computer to the other to communicate so as to execute the program, such as refunding the money to the user. Furthermore, the difference, whether refunding the money to user by the electronic means (via the account) or mailing, would not be distinguished from the prior art in terms of patentability.

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to verify the authenticity of the user's account, send data from the data center's computer to the postage meter, and mail refunds equivalent to the postage amount to the user (because mailing the refund to the user does not patentably distinguish the claimed invention), for the purpose of refunding the money equivalent to the postage amount to the user.

Regarding the Claim 9, EP '956 discloses the invention as cited earlier, but does not expressively disclose the postage metering system having the printing device printing a receipt of the postage amount refunded.

It is well known in any art of retailing business to print the receipt for the record of refunding by the request of the customer (or the user).

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to print the receipt of the postage amount refunded because printing the receipt for the user does not patentably distinguish the claimed invention.

6 Claims 1-6, 9, 11-14 and 17-19, as far as they are definite, are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitehouse (US 6,005,945).

Regarding the method claims, Whitehouse discloses the method having the steps of:

- receiving a refund request;
- verifying the request via a computer;
- sending the refund request to a postal authority by a data center (102);
- refunding the postage amount to a user of the postage meter;
- adjusting the user's account to reflect the refund;
- rejecting the refund when the refund request would not be authenticated;
- wherein the postage meter is remotely located from the computer (see Fig. 4);
- maintaining a transaction record (database in the data center); and
- wherein the refund amount must correlate to a postage value previously dispensed by the postage meter.

However, Whitehouse does not expressively disclose:

the method of determining if a value in the user's account is acceptable for permitting a refund of the postage amount;

sending enabling data from the computer to the postage meter to effectuate the refund; and

the method of mailing funds equivalent to the postage amount to the user; and

As long as the Post Office can authenticate whether the user has a compelling reason for the refund and the user has a valid account, any user's account is acceptable for permitting the refund of the postage amount. In order to effectuate the refund, the data transmission between the data center and the postage meter is clearly required. As Fig. 4 of Whitehouse shows the diagram depicting that the data center is communicating with the postage meter, it is well known in the art to send data from one computer to the other to communicate so as to execute the program, such as refunding the money to the user. Furthermore, the difference, whether refunding the money to user by the electronic means (via the account) or mailing, would not be distinguished from the prior art in terms of patentability.

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to verify the authenticity of the user's account, send data from the data center's computer to the postage meter, and mail refunds equivalent to the postage amount to the user (because mailing the refund to the user does not patentably distinguish the claimed invention), for the purpose of refunding the money equivalent to the postage amount to the user.

Regarding the Claim 9, Whitehouse discloses the invention as cited earlier, but does not expressively disclose the postage metering system having the printing device printing a receipt of the postage amount refunded.

It is well known in any art of retailing business to print the receipt for the record of refunding by the request of the customer (or the user).

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to print the receipt of the postage amount refunded because printing the receipt for the user does not patentably distinguish the claimed invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-3691 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo
Patent Examiner
GAU 3629
July 10, 2003



DEANT. NGUYEN
PRIMARY EXAMINER